

REMARKS

In the Office Action, the Examiner rejected claims 1-20. Applicant has not made any amendments by the present paper, therefore claims 1-20 remain pending in the present application and are believed to be in condition for allowance. In view of the following remarks, Applicant respectfully requests reconsideration and allowance of all pending claims.

Claim Rejections under 35 U.S.C. § 102

The Examiner rejected claims 1-4 and 13 under 35 U.S.C. § 102(b) as anticipated by Reynolds (U.S. Patent No. 3,825,335). Applicant respectfully submits that independent claims 1 and 13 recite features not disclosed in the cited reference.

Legal Precedent and Guidelines

Anticipation under 35 U.S.C. § 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under 35 U.S.C. § 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, Applicant needs only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the identical invention “in as complete

detail as contained in the ... claim” to support a *prima facie* case of anticipation.

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Claim Features of Independent Claims Omitted from Cited Reference

Turning to the claims, independent claims 1 and 13 recite, *inter alia*, “A physiological sensor ... to enable measurement of a physiological parameter.” (Emphasis added). Regarding the previously-presented amendments to claims 1 and 13, the Examiner stated that “the amended preamble does not appear to impose any structural limitations on the claimed elements, and those claimed elements remain structurally indistinguishable from those of Reynolds.” Office Action, page 3. However, despite the Examiner’s argument that the preamble does not provide a structural limitation, recitation of a physiological sensor is structural. That is, a sensor is a specific type of device, and a reference that does not disclose a sensor cannot anticipate the present claims. The Reynolds reference does not disclose a physiological sensor and therefore cannot anticipate the presently recited sensor.

In addition, the Examiner seems to be overlooking the amended body of the claims which state that the sensor “enable[s] measurement of a physiological parameter.” These amendments to claims 1 and 13 clearly impose a structural limitation on the claimed sensor. That is, the sensor must have a structure which “enable[s] measurement of a physiological parameter” as recited in claims 1 and 13. The Examiner has failed to identify how the variable lighting system for photography disclosed in the Reynolds

reference measures a physiological parameter. On the contrary, the cited reference merely includes colored lights for illuminating a scene for color photography. *See* Reynolds, col. 1, lines 7-10. For at least these reasons, the Reynolds reference does not anticipate independent claims 1 and 13, or their dependent claims. Applicant therefore respectfully requests withdrawal of the rejections under 35 U.S.C. § 102.

Claim Rejections under 35 U.S.C. § 103

The Examiner rejected claims 5-9, 11-16, and 18-20 under 35 U.S.C. § 103(a) as obvious over Vari et al. (U.S. Patent No. 5,701,902) in view of Reynolds. In addition, the Examiner rejected claims 10 and 17 under 35 U.S.C. § 103(a) as obvious over Vari and Reynolds in view of Jeffcoat et al. (U.S. Patent No. 5,036,853). Applicant respectfully traverses the use of the Reynolds reference as prior art in the present application and the combination of the cited references. Furthermore, the Examiner has not met the burden of proof in establishing a *prima facie* case of obviousness regarding claims 5-20.

Legal Precedent and Guidelines

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). In making a rejection under 35 U.S.C. § 103, it is improper for the Examiner to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. In addition, there must be some reason to combine references other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability,

and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The Federal Circuit has warned that the Examiner must not, “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *In re Dembiczak*, F.3d 994, 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)).

Furthermore, in addressing obviousness determinations under 35 U.S.C. § 103, the Supreme Court in *KSR International Co. v. Teleflex Inc.*, No. 04-1350 (April 30, 2007), reaffirmed many of its precedents relating to obviousness including its holding in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). In *KSR*, the Court also reaffirmed that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *Id.* at 14. In this regard, the *KSR* court stated that “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does ... because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *Id.* at 14-15. In *KSR*, the court noted that the demonstration of a teaching, suggestion, or motivation to

combine provides a “helpful insight” in determining whether claimed subject matter is obvious. *KSR*, *slip op.* at 14.

The *KSR* court also did not diminish the requirement for objective evidence of obviousness. *Id.* at 14 (“To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”); *see also*, *In re Lee*, 61 U.S.P.Q.2d 1430, 1436 (Fed. Cir. 2002) (holding that the factual inquiry whether to combine references must be thorough and searching, and that it must be based on objective evidence of record).

Furthermore, non-analogous art cannot properly be pertinent prior art under 35 U.S.C. § 103. *In re Pagliaro*, 210 U.S.P.Q. 888, 892 (C.C.P.A. 1981). For the teachings of a reference to be prior art under 35 U.S.C. § 103, there must be some basis for concluding that the reference would have been considered by one skilled in the particular art working on the particular problem with which the invention pertains. *In re Horne*, 203 U.S.P.Q. 969, 971 (C.C.P.A. 1979). The determination of whether a reference is from a non-analogous art is set forth in a two-step test given in *Union Carbide Corp. v. American Can Co.*, 724 F.2d 1567, 220 U.S.P.Q. 584 (Fed. Cir. 1984). In *Union*

Carbide, the court found that the first determination was whether “the reference is within the field of the inventor’s endeavor.” If it is not, one must proceed to the second step “to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.” In regard to the second step, *Bott v. Four Star Corp.*, 218 U.S.P.Q. 358 (E.D. Mich. 1983), determined that “analogous art is that field of art which a person of ordinary skill in the art would have been apt to refer in attempting to solve the problem solved by a proposed invention.” “To be relevant the area of art should be where one of ordinary skill in the art would be aware that similar problems exist.” *Id.*

Request Removal of Non-Analogous Art

Based on the foregoing two-part non-analogous art test, the Reynolds reference does not qualify as analogous art. In regard to the first step of the *Union Carbide* test, the photographic lighting system of Reynolds is clearly not in the field of Applicant’s endeavor. That is, a lighting system for color photography is not related to a sensor for measuring a physiological parameter of a patient.

In regard to the second step of the *Union Carbide* test, the photographic lighting system of the Reynolds reference is not reasonably pertinent to the problem with which Applicant was involved. The present application is related to homogenizing electromagnetic energy output from a medical sensor to a tissue location for the purpose of measuring a physiological parameter. *See* Application, ¶ [0001]. In contrast, the Reynolds reference is related to illuminating a scene with a desired color to enhance color photography. *See* Reynolds, Abstract. There is no objective reason that one skilled in the

art of physiological sensors would consider a color photography lighting system in attempting to solve problems associated with the measurement of physiological parameters. That is, the variable color lighting system of Reynolds has no bearing on the electromagnetic homogeneity output problem solved by the present disclosure. Thus, there is no evidence whatsoever that similar problems exist in these disparate fields of art. Accordingly, the Reynolds reference is believed to be non-analogous art. Applicant respectfully requests removal of the Reynolds reference from consideration.

Improper Combination

Furthermore, even if, *arguendo*, the Reynolds reference is not non-analogous art, the Examiner has not made a *prima facie* case of obviousness regarding the combination of the Reynolds, Vari, and/or Jeffcoat references. That is, regarding the rejections under 35 U.S.C. § 103, the Examiner stated that “there is no teaching in either of the references that the suggested modification was improper.” Office Action, page 3. The Examiner further stated that “there is no teaching in either reference that excludes substitution of the arrangement or method of the other invention for achieving the resulting mixed light output from the sources.” Office Action, page 4. However, this is an incorrect application of established legal precedent. That is, the test for obviousness is not whether the cited references suggest that the proposed modification is improper, but rather whether there is any objective evidence of a reason to combine the cited references. The Examiner has not provided such objective evidence and therefore has improperly combined the primary Vari and Reynolds references.

Specifically, the Vari reference teaches random dispersion of optical fiber bundles 48-54. *See* Vari et al., col. 5, lines 24-27. In contrast, the Reynolds reference specifically discloses ordered distribution of optical fibers carrying red, green, and blue light. *See* Reynolds, col. 6, lines 43-48. The Examiner suggested that these references teach alternative manners in which to achieve the same result and therefore can be interchanged/combined. However, as the Examiner has admitted that each reference provides a method to solve the homogeneity problem, there is clearly no reason to combine the references. That is, because there is not a problem in one reference, it is not reasonable to seek an alternate solution from another reference. The only reason the Examiner could have for suggesting that these references are combinable is to disparage the present application. For at least this reason, the proposed combination is improper and must be withdrawn.

In addition, the Jeffcoat reference, combined with either the Vari reference or the Reynolds reference, does not obviate the deficiencies of either reference with regard to disclosing all elements of the independent claims, as discussed above and in the Response to Office Action mailed January 23, 2007. In view of these deficiencies, among others, Applicant respectfully requests withdrawal of the rejection of claims 5-20 under 35 U.S.C. § 103.

Conclusion

In view of the remarks set forth above, Applicant respectfully requests reconsideration of the Examiner's rejections and allowance of all pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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